



C. PCT 1196

November 16, 2009

Madam,
Sir,

1. This Circular is addressed to your Office in its capacity as a receiving Office, International Searching Authority, International Preliminary Examining Authority, and/or designated or elected Office under the Patent Cooperation Treaty (PCT). It is also being sent to organizations which are invited to attend meetings of the PCT Working Group as observers, as well as to Geneva based missions and foreign ministries of PCT Contracting States.

2. At its second session, held in Geneva from May 4 to 8, 2009, the PCT Working Group considered proposals for the future development of the PCT system, including a draft roadmap by the International Bureau (document PCT/WG/2/3) for improving the use of the PCT within its existing legal framework.

3. The Working Group's discussions are outlined in the detailed report of the session (document PCT/WG/2/14, paragraphs 11 to 98) and in the summary of the session by the Chair (document PCT/WG/2/13, paragraphs 4 to 9), which is reproduced in the following paragraphs:

“4. Discussions were based on documents PCT/WG/2/3, 8, 11 and 12.

“5. The Meeting agreed that the relevant PCT bodies should continue their work to improve the PCT. The Meeting agreed that the PCT system can and should function more effectively, within the existing legal framework of the Treaty provisions,

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- to deliver results which meet the needs of applicants, Offices and third parties in all Contracting States;
- without limiting the freedom of Contracting States to prescribe, interpret and apply substantive conditions of patentability and without seeking substantive patent law harmonization or harmonization of national search and examination procedures.

“6. The Meeting agreed that the relevant PCT bodies should discuss ways in which the objective set out in paragraph 5, above, could be achieved,

- taking an incremental approach;
- in a member-driven process, involving broad-based consultations with all stakeholder groups, including regional information workshops;
- taking into account the recommendations contained in the WIPO Development Agenda;
- taking into consideration the topics addressed in the draft roadmap proposed by the International Bureau in document PCT/WG/2/3, subject to the discussions set out in the Working Group’s report, taking note of certain concerns expressed by Contracting States, and taking note of any other topics which Contracting States may wish to address in order to achieve the objective set out in paragraph 5.

“7. The Meeting agreed that the work set out in paragraph 6, above, should be informed by an in-depth study factoring in, but not limited to, the following elements:

- outlining the background of the need to improve the functioning of the PCT system;
- identifying the existing problems and challenges facing the PCT system;
- analyzing the causes underlying the problems;
- identifying possible options to address the problems;

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- evaluating the impact of the proposed options;
- defining and clarifying concepts, such as ‘duplication of work’, ‘unnecessary actions’ etc.

“The Meeting recommended that this study be prepared and submitted to the Working Group at least two months before the next Working Group meeting.

“8. The Meeting agreed on the importance of fee reductions and capacity building measures, including in patent drafting and filing, and agreed that the relevant PCT bodies should prepare proposals, including fee reductions and capacity building measures, to increase access to the PCT for independent inventors and/or natural persons, small and medium sized enterprises and universities and research institutions, in particular from developing and least developed countries.

“9. The Meeting recommended that technical assistance be enhanced for national and regional Offices of developing and least developed countries in order that they may benefit fully from the PCT system, and the Meeting agreed on the importance of facilitating participation by representatives of Offices of developing and least developed countries in the meetings of the PCT Working Group.”

4. The primary purpose of this Circular is to gather background information, by way of the Questionnaire attached in Annex I, from your Office as a receiving Office, International Searching Authority, International Preliminary Examining Authority and/or designated or elected Office, which will be used as input into the study by the International Bureau referred to in paragraph 7 of document PCT/WG/2/13 (reproduced above). At the same time, it offers an opportunity to provide additional information on the matters set out in paragraphs 8 and 9 of that document and any other matters which you consider were not or not sufficiently addressed in the discussions in the second session of the PCT Working Group.
5. As background information, Annex II contains the 45 adopted WIPO Development Agenda recommendations.
6. While some of the questions in the Questionnaire attached in Annex I are addressed to Offices in their various PCT capacities, all recipients of the Circular are invited to give their comments on the issues which are raised in any of the questions in which they may be interested, including the policy issues which underlie the questions themselves.

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7. You are kindly requested to complete the Questionnaire attached in Annex I and to return it to the International Bureau, or to submit any other comments you may have on the issues raised in the questions, by *January 17, 2010*, preferably by e-mail sent to my colleague Mr. Claus Matthes, Director, PCT Business Development Division (*claus.matthes@wipo.int*; fax: (+41-22) 338 7150; tel.: (+41-22) 338 9809). Responses to this Questionnaire may be submitted in any of the 6 official languages of the United Nations (Arabic, Chinese, English, French, Russian and Spanish).

8. Responses by as many Offices and governments as possible would greatly assist in ensuring that the next steps in the development of the PCT address the needs of all Contracting States effectively.

9. Mr. Matthes and Mr. Michael Richardson, Counsellor, PCT Business Development Division (*michael.richardson@wipo.int*; fax: (+41-22) 338 7150; tel.: (+41-22) 338 9171) would also be happy to answer any queries you may have concerning the Questionnaire or to discuss informally matters related to the future development of the PCT system.

10. An electronic version of the Questionnaire, which you are encouraged to use for submitting response as an attachment to an e-mail, is available on the WIPO website at the following address: *http://www.wipo.int/pct-wg/en/*.

Yours sincerely,



Francis Gurry
Director General

Enclosures: Annex I: Questionnaire
Annex II: Adopted WIPO Development Agenda recommendations

ANNEX I TO CIRCULAR C. PCT 1196

QUESTIONNAIRE

FUTURE DEVELOPMENT OF THE PCT

RESPONSE FROM:

Name of responsible official:

On behalf of *[State, Office or Organization]*:

Type of national/regional patent system:

- full examination – grant only once defects have been corrected
- search or search and substantive examination made and results published, not requiring substantive defects to be corrected before registration
- registration without mandatory search and examination
- other *[give details]*

Note: While the questions in this Questionnaire are mainly addressed to Offices in their various PCT capacities, all recipients of the Circular are invited to give their comments on the issues which are raised in the questions, including the policy issues which underlie the questions themselves.

A. USE OF PCT REPORTS TO ASSIST DECISION MAKING IN THE NATIONAL PHASE

1. To what extent does your Office, during national phase processing, find the international search report to be useful as the basis for finding the most relevant prior art?

Include details such as:

- *whether this depends on which particular International Authority(ies) conducted the work in the international phase;*
- *the type of any additional searching which your Office performs (complete new searches; specific languages; “top-ups” for documents which had not been present in search databases at the time that the international search was conducted);*
- *whether additional searching is conducted routinely in all cases or to different degrees following consideration of the indicated scope of the specific international search report and other indicators of likely quality.*

2. To what extent does your Office find international preliminary reports on patentability to be useful as the basis for beginning national phase processing in your Office and in particular in helping to identify whether the substantive requirements of your national law have been met?

Include details such as:

- whether this depends on which particular International Authority(ies) conducted the work in the international phase;*
- whether it depends on whether the report was issued under Chapter I (with the search report) or Chapter II (following international preliminary examination, including the possibility of the applicant having made amendments);*
- whether it depends on whether, subsequent to the international report being established, the applicant has filed amendments upon entry into the national phase or thereafter.*

3. If your Office routinely conducts additional national search or examination on all international applications which have entered the national phase before your Office, why is this considered necessary as a matter of policy?

For example:

- *Are national standards for patentability significantly different from those required to be tested in the international phase of the PCT? For some fields of technology only, or more generally?*

- *Is there a perception that the international search and preliminary examination are not consistently conducted to a sufficiently high standard against the standards which are required to be tested? In what ways (languages of documentation searched; basis for opinions on novelty and inventive step; completeness and clarity of written opinions)?*

4. Should the definitions of what is required in an international search report or international preliminary report on patentability, or more generally the form or content of those reports, be changed, and if so, in what ways, to make these reports more useful to your Office?

Note that these definitions are specifically not supposed to reflect the national law of any individual Contracting State, but are supposed to be useful to all Contracting States in helping applicants, Offices or third parties to determine whether an international application is likely to meet the requirements of any particular national law.

Perhaps most notably, the definition in PCT Rule 33.1 is intended to require the International Searching Authority to list all disclosures which the examiner is capable of finding which could be of relevance to determining the questions of novelty or inventive step under the laws of any Contracting State, including oral disclosures (noting that no examiner would be capable of discovering an oral disclosure without a reference to it in written form). Any information on situations where this would not be the case would be particularly valuable.

5. If your Office finds that an international application does not meet the requirements of your national law when it first enters the national phase and requires the applicant to file amendments, are the international search report and international preliminary report on patentability useful in assisting your Office to determine whether the defects have been overcome by the amendment?

Please indicate any ways in which you think that the reports or PCT process might be improved to make international reports more useful beyond the first action in the national phase.

6. Are there any other specific ways in which you believe that the PCT could better meet the needs of your Office in assisting the processing, according to the national law of your country, of international applications which have entered the national phase before your Office?

This might include changes to the reports or other aspects of the international process, or alternatively to matters of technical assistance and cooperation between Offices in the national phase, to the extent that you consider this to be appropriate within the umbrella of the PCT.

B. BACKLOGS AND TIMING

7. Approximately how many applications are pending at your Office, including both direct national applications and international applications which have entered the national phase?

If possible, give figures for each of the last 10 years.

8. What is the average time to grant or final rejection for an application in your Office (including both direct national applications and international applications which have entered the national phase)?

If possible, give figures for the last 10 years.

Preferably, the figures should be calculated from the request for examination (for systems where substantive examination is conducted); in the case of divisional or continuation applications, the figure should be calculated from the date of request for examination of the earliest parent.

If a different methodology is used, please briefly indicate.

9. Does the time to grant indicated above vary greatly according to different types of application?

For example, do the times depend on the subject matter involved or whether the application is an international application compared to a direct national application?

C. TECHNICAL AND LEGAL INFORMATION

10. How could the delivery by the International Bureau of PCT related information (including legal information related to the processing of applications as well as technical information contained within them) to your Office and to users of technical information in your country be improved?

D. DEVELOPMENT AND TRAINING

11. What practical steps should be taken as part of a review of the functioning of the PCT system to address relevant recommendations of the WIPO Development Agenda?

The adopted 45 WIPO Development Agenda recommendations are reproduced in Annex II.

The adopted WIPO Development Agenda Recommendations referred to by Member States during the discussions in the PCT Working Group and the PCT Assembly on the future development of the PCT system are recommendations 15, 17, 20, 21, 22 and 44 (set out in bold in Annex II), all of which fall under Cluster B (“Norm Setting, Flexibilities, Public Policy and Public Domain”) or D (“Institutional Matters including Mandate and Governance”).

Noting that the process as envisaged by the Director General and agreed upon by Member States (see document PCT/WG/2/14, paragraphs 94 to 96) is aimed at improving the PCT system so that it can function more effectively within the existing legal framework, that is, without introducing any new norms, and that, according to the Program and Budget 2010/2011 for Program 5 (“The PCT System”), the PCT Program incorporates activities related to adopted Development Agenda recommendations 1, 6, 10 and 31 (set out in italics in Annex II), comments are also welcome in respect of any of the 45 adopted Development Agenda recommendations, notably on issues covered under Clusters A (“Technical Assistance and Capacity Building”) and C (“Technology Transfer, Information and Communication Technologies (ICT) and Access to Knowledge”).

12. What more should be done within the PCT system to assist technology transfer and identifying technologies which have fallen into the public domain?

Recommendation 20 and Cluster C of the recommendations under the Development Agenda deal generally with questions of promoting technology transfer and identification of off-patent technologies which can be freely exploited.

The PATENTSCOPE[®] website seeks to address part of this issue by allowing a free search of technical information and showing where international applications have entered the national phase, but information is only provided by a limited range of Offices and few provide ongoing status information such as when patents lapse. Moreover, similar information is also needed for Paris route applications in order to allow a full picture to be seen.

Responses might cover:

- how the International Bureau might help national Offices to collect and distribute all the information required to provide a complete picture to local industry;*
- consideration of how the PCT and related systems such as PATENTSCOPE might help foster agreements relating to the transfer of know-how associated with inventions covered by international applications; or*
- any other matters relating to the PCT which should be considered at an international level to promote technology transfer.*

13. If the PCT is little used in your country, either in terms of filings of international applications by local innovators or in terms of national phase entries by foreign applicants, what (if any) specific further action should be considered to increase use of the PCT system in your country or to encourage use by particular classes of innovators (such as local SMEs) and investors, in accordance with broader national policies?

Taking into account Clusters A and C of the recommendations under the Development Agenda, responses might cover:

- the types of improvement to the system which might make it more accessible (such as by simplifying matters which cause difficulties to applicants from or in your country or alternative fee structures);*
- improvements to the training and promotion of the PCT provided by the International Bureau, or to the material provided to assist Offices and others in such promotion;*
- discussion of policy issues concerning how the PCT could contribute to national IP strategies, including strategies to encourage local research and inward investment and strengthen local SMEs.*

14. How could PCT-related training and general information offered to your Office and (potential) PCT users in your country by the International Bureau, or by other Offices, governments and organizations in cooperation with the International Bureau, be improved, other than in relation to the issues set out in question 13, above?

Please indicate the specific areas of training in which you would like to see improvement and indicate possible ways of addressing the issue, whether by addressing the content of training and information or by seeking more efficient and effective means of delivery.

Noting Clusters A and C of the Development Agenda recommendations, responses might extend to how training and information could better be tailored to meeting and/or developing national IP strategies, including strategies to encourage local research and inward investment and strengthen local SMEs.

E. OTHER ISSUES

15. Are there any other ways in which the operation of the PCT system could be improved, within its existing legal framework, to better meet the needs of your Office, State and/or user community, including all third party interests in addition to those of applicants for patents?

[End of Questionnaire – Annex II
follows]

ANNEX II TO CIRCULAR C. PCT 1196

ADOPTED WIPO DEVELOPMENT AGENDA RECOMMENDATIONS

At the 2007 General Assembly, WIPO Member States adopted 45 recommendations (of the 111 original proposals) made by the Provisional Committee on Proposals Related to a WIPO Development Agenda (PCDA). The 45 adopted recommendations are listed below in the following clusters:

- Cluster A: Technical Assistance and Capacity Building
- Cluster B: Norm-setting, flexibilities, public policy and public domain
- Cluster C: Technology Transfer, Information and Communication Technologies (ICT) and Access to Knowledge
- Cluster D: Assessment, Evaluation and Impact Studies
- Cluster E: Institutional Matters including Mandate and Governance
- Cluster F: Other Issues

Recommendations with an asterisk (*) were identified by the 2007 General Assembly for immediate implementation.

Recommendations set out in **bold** (recommendations 15, 17, 20, 21, 22 and 44) are the ones which were referred to during the discussions in the PCT Working Group and the PCT Assembly on the future development of the PCT system.

According to WIPO's Program and Budget 2010/2011 as adopted by WIPO Member States, the PCT Program (Program 5) incorporates activities related to adopted Development Agenda recommendations 1, 6, 10 and 31. Those recommendations are set out in *italics*.

Cluster A: Technical Assistance and Capacity Building

**1. WIPO technical assistance shall be, inter alia, development-oriented, demand-driven and transparent, taking into account the priorities and the special needs of developing countries, especially LDCs, as well as the different levels of development of Member States and activities should include time frames for completion. In this regard, design, delivery mechanisms and evaluation processes of technical assistance programs should be country specific.*

2. Provide additional assistance to WIPO through donor funding, and establish Trust-Funds or other voluntary funds within WIPO specifically for LDCs, while continuing to accord high priority to finance activities in Africa through budgetary and extra-budgetary resources, to promote, inter alia, the legal, commercial, cultural, and economic exploitation of intellectual property in these countries.

*3. Increase human and financial allocation for technical assistance programs in WIPO for promoting a, inter alia, development-oriented intellectual property culture, with an emphasis on introducing intellectual property at different academic levels and on generating greater public awareness on intellectual property.

*4. Place particular emphasis on the needs of small and medium-sized enterprises (SMEs) and institutions dealing with scientific research and cultural industries and assist Member States, at their request, in setting-up appropriate national strategies in the field of intellectual property.

5. WIPO shall display general information on all technical assistance activities on its website, and shall provide, on request from Member States, details of specific activities, with the consent of the Member State(s) and other recipients concerned, for which the activity was implemented.

*6. *WIPO's technical assistance staff and consultants shall continue to be neutral and accountable, by paying particular attention to the existing Code of Ethics, and by avoiding potential conflicts of interest. WIPO shall draw up and make widely known to the Member States a roster of consultants for technical assistance available with WIPO.*

*7. Promote measures that will help countries deal with intellectual property-related anti-competitive practices, by providing technical cooperation to developing countries, especially LDCs, at their request, in order to better understand the interface between IPRs and competition policies.

8. Request WIPO to develop agreements with research institutions and with private enterprises with a view to facilitating the national offices of developing countries, especially LDCs, as well as their regional and sub-regional intellectual property organizations to access specialized databases for the purposes of patent searches.

9. Request WIPO to create, in coordination with Member States, a database to match specific intellectual property -related development needs with available resources, thereby expanding the scope of its technical assistance programs, aimed at bridging the digital divide.

10. To assist Member States to develop and improve national intellectual property institutional capacity through further development of infrastructure and other facilities with a view to making national intellectual property institutions more efficient and promote fair balance between intellectual property protection

and the public interest. This technical assistance should also be extended to sub-regional and regional organizations dealing with intellectual property.

*11. To assist Member States to strengthen national capacity for protection of domestic creations, innovations and inventions and to support development of national scientific and technological infrastructure, where appropriate, in accordance with WIPO's mandate.

*12. To further mainstream development considerations into WIPO's substantive and technical assistance activities and debates, in accordance with its mandate.

*13. WIPO's legislative assistance shall be, inter alia, development-oriented and demand-driven, taking into account the priorities and the special needs of developing countries, especially LDCs, as well as the different levels of development of Member States and activities should include time frames for completion.

*14. Within the framework of the agreement between WIPO and the WTO, WIPO shall make available advice to developing countries and LDCs, on the implementation and operation of the rights and obligations and the understanding and use of flexibilities contained in the TRIPS Agreement.

Cluster B: Norm-setting, flexibilities, public policy and public domain

***15. Norm-setting activities shall:**

- **be inclusive and member-driven;**
- **take into account different levels of development;**
- **take into consideration a balance between costs and benefits;**
- **be a participatory process, which takes into consideration the interests and priorities of all WIPO Member States and the viewpoints of other stakeholders, including accredited inter-governmental organizations (IGOs) and NGOs; and**
- **be in line with the principle of neutrality of the WIPO Secretariat.**

*16. Consider the preservation of the public domain within WIPO's normative processes and deepen the analysis of the implications and benefits of a rich and accessible public domain.

***17. In its activities, including norm-setting, WIPO should take into account the flexibilities in international intellectual property agreements, especially those which are of interest to developing countries and LDCs.**

*18. To urge the IGC to accelerate the process on the protection of genetic resources, traditional knowledge and folklore, without prejudice to any outcome, including the possible development of an international instrument or instruments.

*19. To initiate discussions on how, within WIPO's mandate, to further facilitate access to knowledge and technology for developing countries and LDCs to foster creativity and innovation and to strengthen such existing activities within WIPO.

20. To promote norm-setting activities related to IP that support a robust public domain in WIPO's Member States, including the possibility of preparing guidelines which could assist interested Member States in identifying subject matters that have fallen into the public domain within their respective jurisdictions.

***21. WIPO shall conduct informal, open and balanced consultations, as appropriate, prior to any new norm-setting activities, through a member-driven process, promoting the participation of experts from Member States, particularly developing countries and LDCs.**

22. WIPO's norm-setting activities should be supportive of the development goals agreed within the United Nations system, including those contained in the Millennium Declaration.

The WIPO Secretariat, without prejudice to the outcome of Member States considerations, should address in its working documents for norm-setting activities, as appropriate and as directed by Member States, issues such as: (a) safeguarding national implementation of intellectual property rules (b) links between intellectual property and competition (c) intellectual property-related transfer of technology (d) potential flexibilities, exceptions and limitations for Member States and (e) the possibility of additional special provisions for developing countries and LDCs.

23. To consider how to better promote pro-competitive intellectual property licensing practices, particularly with a view to fostering creativity, innovation and the transfer and dissemination of technology to interested countries, in particular developing countries and LDCs.

Cluster C: Technology Transfer, Information and Communication Technologies (ICT) and Access to Knowledge

24. To request WIPO, within its mandate, to expand the scope of its activities aimed at bridging the digital divide, in accordance with the outcomes of the

World Summit on the Information Society (WSIS) also taking into account the significance of the Digital Solidarity Fund (DSF).

25. To explore intellectual property -related policies and initiatives necessary to promote the transfer and dissemination of technology, to the benefit of developing countries and to take appropriate measures to enable developing countries to fully understand and benefit from different provisions, pertaining to flexibilities provided for in international agreements, as appropriate.

26. To encourage Member States, especially developed countries, to urge their research and scientific institutions to enhance cooperation and exchange with research and development institutions in developing countries, especially LDCs.

27. Facilitating intellectual property -related aspects of ICT for growth and development: Provide for, in an appropriate WIPO body, discussions focused on the importance of intellectual property -related aspects of ICT, and its role in economic and cultural development, with specific attention focused on assisting Member States to identify practical intellectual property -related strategies to use ICT for economic, social and cultural development.

28. To explore supportive intellectual property -related policies and measures Member States, especially developed countries, could adopt for promoting transfer and dissemination of technology to developing countries.

29. To include discussions on intellectual property -related technology transfer issues within the mandate of an appropriate WIPO body.

30. WIPO should cooperate with other IGOs to provide to developing countries, including LDCs, upon request, advice on how to gain access to and make use of intellectual property-related information on technology, particularly in areas of special interest to the requesting parties.

31. To undertake initiatives agreed by Member States, which contribute to transfer of technology to developing countries, such as requesting WIPO to facilitate better access to publicly available patent information.

32. To have within WIPO opportunity for exchange of national and regional experiences and information on the links between IPRs and competition policies.

Cluster D: Assessment, Evaluation and Impact Studies

33. To request WIPO to develop an effective yearly review and evaluation mechanism for the assessment of all its development-oriented activities,

including those related to technical assistance, establishing for that purpose specific indicators and benchmarks, where appropriate.

34. With a view to assisting Member States in creating substantial national programs, to request WIPO to conduct a study on constraints to intellectual property protection in the informal economy, including the tangible costs and benefits of intellectual property protection in particular in relation to generation of employment.

*35. To request WIPO to undertake, upon request of Member States, new studies to assess the economic, social and cultural impact of the use of intellectual property systems in these States.

36. To exchange experiences on open collaborative projects such as the Human Genome Project as well as on intellectual property models.

*37. Upon request and as directed by Member States, WIPO may conduct studies on the protection of intellectual property, to identify the possible links and impacts between intellectual property and development.

38. To strengthen WIPO's capacity to perform objective assessments of the impact of the organization's activities on development.

Cluster E: Institutional Matters including Mandate and Governance

39. To request WIPO, within its core competence and mission, to assist developing countries, especially African countries, in cooperation with relevant international organizations, by conducting studies on brain drain and make recommendations accordingly.

40. To request WIPO to intensify its cooperation on IP related issues with United Nations agencies, according to Member States' orientation, in particular UNCTAD, UNEP, WHO, UNIDO, UNESCO and other relevant international organizations, especially the WTO in order to strengthen the coordination for maximum efficiency in undertaking development programs.

41. To conduct a review of current WIPO technical assistance activities in the area of cooperation and development.

*42. To enhance measures that ensure wide participation of civil society at large in WIPO activities in accordance with its criteria regarding NGO acceptance and accreditation, keeping the issue under review.

43. To consider how to improve WIPO's role in finding partners to fund and execute projects for intellectual property -related assistance in a transparent and member-driven process and without prejudice to ongoing WIPO activities.

***44. In accordance with WIPO's member-driven nature as a United Nations Specialized Agency, formal and informal meetings or consultations relating to norm-setting activities in WIPO, organized by the Secretariat, upon request of the Member States, should be held primarily in Geneva, in a manner open and transparent to all Members. Where such meetings are to take place outside of Geneva, Member States shall be informed through official channels, well in advance, and consulted on the draft agenda and program.**

Cluster F: Other Issues

45. To approach intellectual property enforcement in the context of broader societal interests and especially development-oriented concerns, with a view that “the protection and enforcement of intellectual property rights should contribute to the promotion of technological innovation and to the transfer and dissemination of technology, to the mutual advantage of producers and users of technological knowledge and in a manner conducive to social and economic welfare, and to a balance of rights and obligations”, in accordance with Article 7 of the TRIPS Agreement.

[End of Annex II and of Circular]